

REMARKS

Claims 1, 4, 6-30 and 33-55 are pending. Claims 2-3, 5, and 31-32 have been previously cancelled.

A complete listing of claims is provided for the Examiner's convenience, although no amendments are made herein.

Claims 1, 6, 7, 9-13, 15-26, 28-30, 33, 36, 38, and 39 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,866,889 ("Weiss") in view of U.S. Patent No. 5,485,370 ("Moss"). Claims 4, 8, 14, 27, 34, 35, 37 and 40-55 are rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Weiss in view of Moss and Official Notice (now admitted prior art).

Rejection of Claims 1, 6, 7, 9-13, 15-26, 28-30, 33, 36, 38, and 39 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1, 6, 7, 9-13, 15-26, 28-30, 33, 36, 38, and 39 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Weiss in view of Moss. This rejection is respectfully traversed.

Neither Weiss nor Moss qualify as art under 35 U.S.C. § 103(a). Weiss is assigned to Citibank, N.A., was filed on June 7, 1995, and issued on February 2, 1999. Moss is assigned to Transaction Technology, Inc., was filed on August 25, 1993, and issued on January 16, 1996. The assignee of the present application is Citicorp Development Center, Inc. Citibank, N.A., Transaction Technology, Inc. and Citicorp Development Center, Inc. are commonly owned by the same entity. Accordingly, Weiss, Moss, and the present application are all subject to assignment to the same entity.

Leslie Moss is an inventor of the pending application as well as an inventor of Moss. Because the other inventors listed on the present application and Moss are different, Moss qualifies under 35 U.S.C. § 102(f) because it was invented by another entity. See MPEP 2137.01. Moss also qualifies under 35 U.S.C. § 102(g). Weiss qualifies under 35 U.S.C. § 102(f) as well as 35 U.S.C. § 102(g).

For applications filed prior to November 29, 1999 and granted as patents prior to December 10, 2004, 35 U.S.C. § 103(c) is limited on its face to subject matter developed by another person which qualifies as prior art only under subsection (f) or (g) of section 102. See

MPEP §§706.02(l)(1); 2141.01. As stated above, both Moss and Weiss were developed by another and qualify as prior art under 35 U.S.C. §§ 102(f) and (g) and are owned by the same entity. Therefore, both Moss and Weiss are unavailable as prior art pursuant to 35 U.S.C. § 103(c).

Accordingly, the rejection of claims 1, 6, 7, 9-13, 15-26, 28-30, 33, 36, 38, and 39 under 35 U.S.C. § 103(a) has been rendered moot. Thus, it is respectfully requested that this rejection be withdrawn.

Rejection of Claims 4, 8, 14, 27, 34, 35, 37, and 40-55 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 4, 5, 8, 14, 27, 34, 35, 37 and 40-55 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Weiss in view of Moss and further in view of Official Notice. For the reasons discusses above with respect claims 1, 6, 7, 9-13, 15-26, 28-30, 33, 36, 38, and 39, the undersigned respectfully requests that the rejection of claims 4, 5, 8, 14, 27, 34, 35, 37 and 40-55 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account 50-4402.

Respectfully submitted,

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KING & SPALDING LLP
1700 Pennsylvania Ave., NW, Suite 200
Washington, DC 20006
(202) 626-8980

By: /Eric Sophir, Reg. No. 48,499/
Eric L. Sophir
Registration No. 48,499